

REMARKS

The non-final Office Action dated 18 October 2006 has been received and its contents carefully studied. Claims 1-27, 35-43, and 45-50 are pending. The independent claims were method claim 1, mechanism claim 20, apparatus claim 26, method claim 41, and apparatus claim 49.

All claims stand rejected as being anticipated under 35 U.S.C. 102(e) by *Doyle et al* (U.S. Pat. No. 6,968,453). The final Office Action (e.g. at pages 8, 9, and 18) also relies upon *Hind* (U.S. Patent No. 6,976,163), which *Doyle* says is incorporated by reference. However, for the reasons described below, *Doyle* alone does not teach or suggest the present amended claims, nor does *Doyle* in combination with *Hind* teach or suggest the present amended claims.

The Cited Parts of the *Hind* Reference Are Not Validly Incorporated by *Doyle*

Applicant respectfully submits that a 102(e) rejection is inappropriate here. The *Doyle* reference does not validly incorporate the cited portions of the *Hind* reference, for two independent reasons.

The first independent reason is that the purported incorporation by reference of *Hind* occurs at column 8, lines 5-15 of *Doyle*, whereas *Doyle* never directs attention to the specific portions of *Hind* relied upon by the present Office Action. As the Federal Circuit explained in *Advanced Display v. Kent State*, 54 USPQ2d 1673, 1679 (Fed. Cir. 2000) (emphasis added):

Material not explicitly contained in the single, prior art document may still be considered for purposes of anticipation if that material is incorporated by reference into the document....To incorporate material by reference, the host document must identify with ***detailed particularity what specific material*** it incorporates and clearly indicate where that material is found in the various documents.

Doyle's column 11, line 18 directs attention to *Hind's* column 9, line 49 and column 10, line 33 which deal with selective enablement, but those portions of *Hind* are not relied upon by the present Office Action. The present Office Action says (at pages 8, 9, and 18) that it relies upon column 8, lines 6-11 of *Hind*, to which *Doyle* never refers.

The second independent reason why the *Doyle* reference does not validly incorporate the cited portions of the *Hind* reference is because the purportedly incorporated *Hind* reference did not issue as a patent until after the *Doyle* patent issued, and *Hind* had never before been published. “Incorporation by reference has never been permissible under 35 U.S.C. § 112 of material necessary for an adequate disclosure which is unavailable to the public.” *Quaker City v. Skil*, 223 USPQ 1161, 1167 (1984).

Brief Summary of Present Invention

According to the present invention, a role certificate is for use on a specific device such as a mobile phone, and the role certificate provides for certain enumerated activities to be performed on the device such as downloading or debugging certain types of software code. The role certificate can further enumerate the specific entity (third party) that can perform the enumerated activities on the device.

As described in claim 1, the present method includes embedding in the device a role certificate which identifies a permitted activity, and also embedding public key information in the device corresponding to the private key used by a certification authority (CA) to sign the role certificate. The device is run so as to verify the role certificate using the information regarding the CA public key, causing the permitted activity to be activated within the device by a party if the role certificate is verified.

Instead of the role certificate being provided when a party wants to use the device for some activity, the role certificate is instead provided earlier than that, for example at the time of the device’s manufacture. Then, the role certificate is used to prevent unauthorized parties from engaging in unauthorized activities with the device.

Normally, a role certificate according to the prior art authorizes the device to do something to others. However, in the present invention of claim 1, a role certificate allows others to do something to the device where the role certificate is embedded, for example allowing R&D access to a user’s mobile device so that de-bugging can be performed.

The Present Amendments

Claim 50 is now amended merely to correct a typographical error. Also, the word “only” in claim 26 is now inserted into claims 1, 20, 41, and 49 without prejudice, merely to expedite prosecution of the present application.

Applicant respectfully points out that the “Response to Arguments” in the Office Action relied upon this difference between claim 26 and the other independent claims in order to explain why those other independent claims were anticipated by *Doyle*.

The Present Claims Are Not Anticipated or Obvious

The *Doyle* reference mentions certificates, for example at column 7, lines 13-17. That paragraph of *Doyle* deals with a situation where a portable device is operably connected to one or more components, and the portable device verifies the authenticity of those components. *Doyle* discloses that a certificate is associated with each of the operably connected components (col. 7, lines 13-14). Thus, before the operably connected components are connected to the portable device, there is no relationship or communication at all between *Doyle*’s portable device and the certificates associated with the components — that is very different from the present amended independent claims which specify that the certificate is embedded in said device ***before*** the at least one party communicates with the device to provide identity information and perform the permitted activity. For example, present claim 1 states: “the at least one party communicates with the device to perform the permitted activity, ***after*** the role certificate is embedded in said device” (emphasis added).

The cited FIG. 1 of *Doyle*, and *Doyle*’s description thereof, confirm that the *Doyle* invention is fundamentally different from the invention presently claimed. *Doyle*’s security zone **150** is connected to various components **110**, **170**, and **180**. The final Office Action states that units within the security zone **150** hold a multitude of role certificates. However, *Doyle* discloses that the certificates will be associated with each of the operably connected components (col. 7, lines 13-14) instead of the certificates being associated with the security zone **150**.

The only part of *Doyle*’s preferred embodiment where there is any discussion or suggestion of certificates being stored in the security zone **150** is at column 14, lines 16-

30, and those certificates are used in an entirely different manner from those presently claimed. *Doyle* discloses that certificates stored in the security zone 150 of the secure integrated device shown in FIG. 1 are sent to a receiver of another secure integrated device (col. 14, line 45) in order for the other secure integrated device to authenticate data streams received thereby.

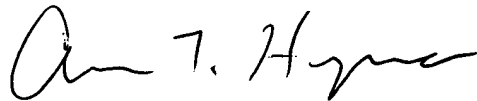
As mentioned above, *Doyle* nowhere refers to the portions of *Hind* relied upon in the Office Action. Likewise, a person skilled in the art would not perceive any suggestion in either reference of any motivation to combine the references. The Abstract of *Hind* specifically says that the certificate may be provided as part of the update, rather than being provided earlier (e.g. before a firmware update is even attempted). According to *Hind*, the update rules are extracted from the certificate. This disclosure of *Hind* is inconsistent with the present claimed invention wherein the certificate is embedded in the device before there is any attempted activity by a third party, e.g. *before* an attempted firmware update.

From a careful study of the *Doyle* patent, and of the *Hind* patent which *Doyle* purports to incorporate by reference, certificates are used only in the usual way, i.e. they are provided from a sending device to a receiving device along with data which must be authenticated. There is no teaching or suggestion that a certificate will be embedded in a receiving device before there is any communication with a sending device, as presently claimed.

CONCLUSION

Because the cited *Doyle* reference does not teach or suggest critical elements of the present independent claims, it is respectfully submitted that those claims are novel and patentable. Thus, allowance of the pending claims is respectfully requested. Applicant would be grateful if the Examiner would please contact Applicant's attorney by telephone if the Examiner detects anything in the present response that might hinder a speedy allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Andrew T. Hyman". The signature is fluid and cursive, with the first name "Andrew" written in a larger, more prominent script than the last name "Hyman".

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